

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Roger PELLENC

Group Art Unit: 2838

Appln. No. : 10/580,155

Examiner: Jue Zhang

Filed : May 19, 2006

Confirmation No.: 8057

For : POWER AUTONOMOUS PORTABLE ELECTRIC TOOL SET

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's election of species requirement of September 17, 2008, the time set for response being extended two (2) months to December 17, 2008, Applicant hereby elects with traverse, Species 7, which is directed to Figure 9. Applicant submits that claims 84 – 93, 95 – 103, 106 – 139, 142 and 143 are readable on the elected species, and at least claims 84 – 93, 106 – 139, 142 and 143 are generic. The above election is made with traverse for the reasons set herein below.

In the election of species requirement of September 17, 2008, the Examiner indicated that all claims (84 – 143) were subject to election under 35 U.S.C. § 121. The Examiner identified has required an election of one of the following species:

Species 1 – Figure 3;

Species 2 – Figure 4:

Species 3 – Figure 5;

Species 4 – Figure 6:

Species 5 – Figure 7;

Species 6 – Figure 8; and

Species 7 – Figure 9.

The Examiner asserts that the species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. Additionally, the Examiner states that these species are not obvious variants of each other based on the current record.

Applicant has elected Species 7 directed to Figure 9 with traverse. Moreover, Applicant acknowledges that, upon allowance of a generic claim, the other species will be rejoined and examined on their merits. The Examiner has identified claim 1 as generic. Applicant notes that claim 1 has been previously canceled, and thus, assumes the Examiner intended to indicate claim 84 as generic. Additionally, Applicant notes that claims 84 – 93, 95 – 103, 106 – 139, 142 and 143 are readable on the elected species (Species 7 directed to Figure 9), and at least claims 84 – 93, 106 – 139, 142 and 143 are generic.

Applicant respectfully submits that the Examiner has not set forth "an appropriate explanation" as to the existence of a "serious burden" if the election requirement were not required, as set forth in M.P.E.P. § 803. The Examiner states that there is an "examination and search burden" for these patentably distinct species due to their mutually exclusive characteristics. More specifically, the Examiner states "[t]he species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to

another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.”

Initially, Applicant notes that the Examiner has not asserted a “serious burden” if the election of species requirement were not required. That is, the Examiner identifies an “examination and search burden” if the election of species requirement were not required. Thus, Applicant submits that the Examiner has not set forth a proper election of species requirement.

Moreover, Applicant respectfully submits the conclusory statements of “examination and search burden” fail to comply with the requirements of M.P.E.P. § 803 of “an appropriate explanation” be advanced by the Examiner as to the existence of a “serious burden” if the election of species requirement were not required. In this regard, the Examiner has not identified any features or burdens specific to the subject matter of the present invention or identified any manner by which a search for the subject matter of the different species would not overlap. Thus, Applicant submits the conclusory statements of the examination and search burden cannot be considered an appropriate explanation under MPEP § 803.

Further, MPEP § 808.02 provides that the Examiner, “in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the Examiner,” and that the Examiner “must show by appropriate explanation one of the following: . . . (A) Separate classification thereof . . . (B) A separate status in the art when they are classifiable together . . . [or] (C) A different field of search.” While the Examiner has included some of these reasons (A) – (C) in their reason for election of species, Applicant reiterates that these are conclusion and not appropriate explanations based upon the specifics of the subject matter of the invention at issue. Further, Applicant submits no appropriate explanation of serious burden has been presented in support of the Examiner’s election of species requirement.

Accordingly, should the Examiner wish to maintain the election of species requirement, Applicant respectfully requests the Examiner provide detailed reasons or explanations in support of the election of species based upon the specifics of this application. Otherwise, the election of species requirement should be withdrawn and all claims 84 - 143 should be examined.

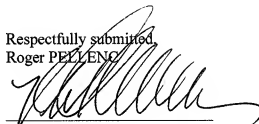
It is Applicant's position that the search for the combination of features recited in the claims of the above-noted species, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is substantially the same, Applicant submits that no undue or serious burden would be presented in concurrently examining Species 1 – Species 7.

Thus, for the above-noted reasons, and consistent with the office policy set forth above in M.P.E.P. §§ 803 and 808.02, Applicant respectfully requests that the Examiner reconsider and withdraw the election of species requirement in this application.

For all of the above reasons, the Examiner's election of species requirement is believed to be improper. Nevertheless, Applicant has elected, with traverse, Species 7, which is directed to Figure 9 and claims 84 – 93, 95 – 103 and 106 – 143, which are readable on the elected species, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Roger PELENC

A handwritten signature in dark ink, appearing to read 'Neil F. Greenblum', written over a horizontal line.

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